

REMARKS

Upon entry of this amendment, claims 1, 3, 4 and 19 will be pending in this application. Claims 2, and 5-18 are cancelled without prejudice or disclaimer, and claim 19 is added. The specification is amended to correct typographical errors. No new matter is added.

Support for the Claim Amendments

Claim 1 is amended to delete the phrase “in a polymer molecule thereof”. This amendment is not intended to narrow the scope of claim 1 and is not made for any substantial reason related to patentability (§§102, 103).

Claim 19 is added to more fully claim the disclosed invention. Support can be found in the specification in ¶¶29 and 30.

No new matter is added.

Rejection of the Claims under 35 U.S.C. § 112, first paragraph

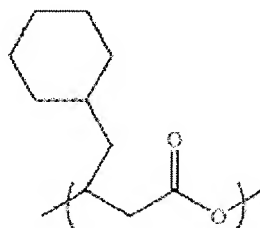
Claims 1, 3 and 4 were rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement. The Examiner stated that “the specification ... does not reasonably provide enablement for the claimed language for the broad language polymers.” (Office Action at 2). Applicants respectfully assert that the specification, including, by way of illustration, Applicants’ Example 1, would enable one of ordinary skill in the art to practice the invention(s) described by pending claims 1, 3 and 4. By this paper, claim 1 is amended to omit the phrase “in a polymer molecule thereof”.

Reconsideration and withdrawal of the Section 112 rejection is respectfully requested.

Rejection of the Claims under 35 U.S.C. § 102(e).

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yano et al., U.S. Patent No. 6,858,367 (“Yano”), because “Yano et al. teaches in Example 6 a product that is considered to be within the scope of the claimed inventions under the doctrine of equivalence since the process employs the same process steps as the instant specification with the exception that 3HCHB is employed instead of 3HCHP [as] claimed.” (Office action at 3).

Yano is directed to, *inter alia*, a binder resin containing polyhydroxyalkanoate. Yano’s example 6 describes a polyhydroxyalkanoate containing a 3-hydroxy-4-cyclohexylbutyric acid (3HCHB) monomer unit. (Yano, Col. 35, lines 49-63). The 3HCHB monomer is illustrated by Yano’s formula (19) as follows:



(Yano, Col. 12, lines 44-59)

As recognized by the office action, Yano’s example 6 does not use the monomer recited in Applicants’ claim 1.

However, the office action argues that it may rely on a “doctrine of equivalence.” Applicants assert that such doctrine is not applicable in this case. A “Prima Facie Case of Equivalence” may be made only if “a prior art element (A) performs the function specified in the claim, (B) is not excluded ..., and (C) is an equivalent of [a] means- (or step-) plus-function limitation.” MPEP §2183 p. 2100-236 (8th edition, Rev. 3, August 2005) (emphasis added). Thus, the “doctrine” is applicable only to a claim having a means-plus-function limitation, which

is not the case with claims 1, 3, or 4 of the present application. Applicants respectfully request withdrawal of the rejections under § 102(e).

Of course, equivalence may also constitute grounds for an obviousness rejection. (See MPEP 2144.06.) However, as described below, Yano is not available as a prior art reference for obviousness over the present application.

Rejection of the Claims under 35 U.S.C. § 103(a).

Claims 1, 3 and 4 were alternatively rejected under 35 U.S.C. 103(a) as being “prima facie obvious ... over Yano.” (Office action at 3.) Applicants respectfully traverse. Yano et al. was owned by or subject to an obligation of assignment to the same entity as the present invention when the present invention was made and therefore, since Yano et al. only qualifies as prior art under § 102(e), Yano et al. can not be held to preclude patentability under §103. 35 U.S.C. § 103(c). As shown on the cover page of the patent, Yano et al. is owned by Canon Kabushiki Kaisha, of Tokyo, Japan. The present invention was assigned by the inventors to Canon Kabushiki Kaisha of Tokyo, Japan, as reflected by the assignment filed on April 7, 2004 and recorded at reel/frame 015193/0700. Applicants respectfully request withdrawal of the rejections under § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

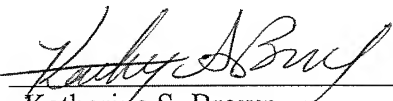
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 1232-5182.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 1232-5182.

Respectfully submitted,
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